

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT L. SCHUPPAN

Appeal No. 95-0517
Application 07/867,049¹

ON BRIEF

Before KIMLIN, JOHN D. SMITH and PAK, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-11, all the claims in the present application. Claims 1 and 7 are illustrative:

¹ Application for patent filed April 10, 1992.

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1. An edible wick comprising:

(a) a suspended component capable of wicking that is fine granular or powdered, non-combustible and edible and;

(b) an edible fuel wherein said combination of suspended component and fuel is effective to maintain a flame in a still room.

7. A method of decorating a foodstuff comprising:

A. obtaining an admixture of:

(i) a fuel selected from the group consisting of oil, fat, wax, alcohol, glycol and combinations thereof; and

(ii) an edible, fine granular or powdered, wicking material wherein between about 30 and 99 percent of said admixture consists of said fuel and between about 1 and about 50 percent of said admixture consists of said edible, fine granular or powdered, wicking material; and

B. applying said admixture to a foodstuff.

The examiner relies upon the following references as evidence of obviousness:

Nisshin	61-186069	Feb. 23, 1988
Hoogeveen	8,403,182	May 16, 1986

Tong J. Lin (Lin), "Fumigating Candles," 80 Chemical Abstracts CA80(16):87430p, p. 287 (1974).

Nobuo Beppu (Beppu), "Candles With Colored Flames," 106 Chemical Abstracts CA106(4):20292g, p. 94 (1987).

The Condensed Chemical Dictionary 864-65, 920 (10th ed., Van Nostrand Reinhold Co., Feb. 22, 1994).

Appellant's claimed invention is directed to an edible wick (claim 1) and a method of decorating a foodstuff (claim 7). The edible wick comprises two components: (a) fine granular or powdered, non-combustible and edible material and (b) an edible fuel, such as vegetable fat or propylene glycol. The wick has the ability to maintain a flame in a still room. The method of decorating foodstuff comprises obtaining a mixture of a fuel and an edible, fine granular or powdered, wicking material, and applying the mixture to a foodstuff.

Appellant submits at page 5 of the Brief that "claims 1-6 and 11 are separately patentable from claims 7-10." Accordingly, claims 1-6 and 11 stand or fall together, as do claims 7-10. In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987); Ex parte Schier, 21 USPQ2d 1016, 1018-19 (Bd. Pat. App. & Int. 1991). See also 37 CFR § 1.192(c)(7) and (c)(8) (1995). In view of appellant's grouping of the appealed claims, we will rule on the propriety of the examiner's prior art rejections of claims 1 and 7, with which the remaining appealed claims stand or fall.

Appealed claim 11 stands rejected under 35 U.S.C. § 112, first and second paragraphs. Appealed claims 1-11 stand

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rejected under 35 U.S.C. § 103 as being unpatentable over either Nisshin or Hoogeveen in view of Hawley, Beppu and Lin.

We consider first the examiner's rejection of claim 11 under 35 U.S.C. § 112, first and second paragraphs. Appellant does not contest the examiner's finding that the term "extrudable" of claim 11 does not find descriptive support in the specification and is indefinite. We note that appellant offers to amend claim 11 to change "extrudable" to "extrudable." Accordingly, we will sustain the examiner's rejection.

We now turn to the examiner's § 103 rejection of the appealed claims over Nisshin or Hoogeveen in view of Hawley, Beppu and Lin. We focus first upon separately argued claim 1. Claim 1 defines a wick comprising an edible fuel in which there is suspended a wicking component that comprises fine granular or powdered, non-combustible, edible material. Neither Nisshin nor Hoogeveen discloses a wicking component that is fine granular or powdered, non-combustible and edible. Although Nisshin discloses an edible candle that has the same advantages of appellant's candle, viz., edible material that can mistakenly but safely be eaten by children which drops onto the

top of cakes and the like during burning, the wicking component of Nisshin's candle is combustible, not non-combustible, as required by claim 1. (See page 3 of the English translation, last paragraph, where it is disclosed "[s]aid wick (3) is composed of a burnable, edible substance".)

Hoogeveen is even more removed from the requirements of claim 1 than Nisshin. Hoogeveen discloses an edible colored pencil, not a wick or candle, which center portion does not contain a material that is either fine granular or powdered, or non-combustible. In addition, although the examiner states that the crayon of Hoogeveen would inherently or obviously maintain a flame, the examiner has not provided factual support for this conclusion. Even though the crayon of Hoogeveen may comprise materials that in and of themselves are flammable, there is no teaching or suggestion in Hoogeveen that the edible colored pencil has the necessary thickness, configuration and composition for the casing and filling to maintain a flame in a still room, as required by claim 1. Indeed, Hoogeveen offers no hint that the colored pencil may also serve as a candle. It is well settled that a determination of inherency cannot be established by

probabilities or possibilities, but it is incumbent upon the examiner to establish the inevitability of the inherency propounded. In Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326, (CCPA 1981); In re Wilding, 535 F.2d 631, 635-36, 190 USPQ 59, 63-64 (CCPA 1976).

Consequently, we are constrained to reverse the examiner's prior art rejection of claims 1-6 and 11.

The examiner's § 103 rejection of claims 7-10 is another matter. Appealed claim 7 simply requires applying a mixture of a fuel and an edible, fine granular or powdered, wicking material to a foodstuff. Claim 7 does not require that the wicking material be non-combustible. In our view, both Nisshin and Hoogveen disclose applying the claimed mixture to a foodstuff. Nisshin's disclosure of applying wicks of rice crackers and dried gourd shavings, which are mixtures of a fuel, such as oil and fat, and an edible, granular material, to a foodstuff such as cake meets the requirements of claim 7. Hoogveen meets the requirements of claim 7 by disclosing the application of the pencil filling to foodstuffs such as cookies and wafers, which fillings include edible oils and fats which may contain crystals or small spheres such as sugar

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crystals or cocoa butter (see English translation at page 2, first paragraph; page 3, lines 21 and 22; and paragraph bridging pages 5 and 6). Appellant's argument at page 13 of the Brief that "[n]othing in any of the cited art suggests a material that a consumer can shape and which will burn in its shape" is not germane to claim 7 on appeal, which does not require a material that can be shaped and burn in its shape.

In conclusion, based on the foregoing, the examiner's rejection of claim 11 under 35 U.S.C. § 112, first and second paragraphs, is affirmed, as is the examiner's rejection of claims 7-10 under 35 U.S.C. § 103. The examiner's rejection of claims 1-6 and 11 under 35 U.S.C. § 103 is reversed. The examiner's decision is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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JOHN D. SMITH)	BOARD OF PATENT

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Administrative Patent Judge)	APPEALS AND
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